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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAY, LINDA LAMEY

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/753,415	Applicant(s) COURTNEY, RICHARD	
	Examiner Linda L Gray	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 17-24 is/are rejected.
- 7) ☒ Claim(s) 14, 15 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ****. | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-8 and 16**, drawn to a wood board, classified in class 428, subclass 106
 - II. **Claims 9-15 and 17-24**, drawn to a method, classified in class 156, subclass 257.
2. The inventions are distinct, each from the other because of the following reasons: Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case bonding the layers simultaneously.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. In a preliminary amendment filed 1-9-04, an election was made without traverse to prosecute the invention of Group II, claims 9-15 and 17-24. Claims 1-8 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objection

5. **Claims 14-15 and 24** are objected to because of the following informalities: (a) **claims 14-15**, "layers are" should be changed to "layer is" in that one core layer is recited and (b) **claim 24**, "comprise" should be changed to "comprises". Appropriate correction is required.

Specification

6. The disclosure is objected to because of the following informalities: the patent number of the parent case should be included in the continuation portion of the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 9-15 and 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

Claim 9 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, "wherein said pierced slots do not cause appreciable expansion of the resulting wood board" is new matter. Also, the values for the strips in **claim 22** are not supported in the originally filed application.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-13, 15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tellman (US 4,655,869).

Claim 9, Tellman teaches a method of manufacturing wood boards 10. The method includes forming a core layer including preparing back veneer 16. Veneer layer 14, having longitudinally pierced slots therein oriented in parallel with its respective longitudinal grain structure, is adhered upon veneer 16 to form a stack of layered veneers wherein the structure of veneer 16 and layer 14 are perpendicularly oriented with respect to each other. Sliced wood veneer face layer 12 is shown adhered on the core layer such that the longitudinal grain structure of layer 12 is perpendicularly oriented with respect to the structure of veneer 16 of the core layer. Tellman indicates layer 12, layer 14, and veneer 16 are all bonded together and does not indicate any restrictions particular order of bonding. Layer 12, layer 14, and veneer 16 are cut from species which is longitudinally cut depending upon the frame of reference (c 2, L 24, to c 4, l 65). Note in column 5, lines 44-47, that veneer 16 and layer 12 can have longitudinally pierced slots therein oriented in parallel with its longitudinal grain structure.

Tellman does not teach adhering layer 12 after veneer 16 and layer 14 are bonded together.

Step wise bonding of layers on upon the other are conventional, i.e., layer 1 to layer 2 to form layer 3; then bond layer 4 to layer 3, etc. because such allows on to

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control the relative position of the individual layers precisely, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Tellman adhering layer 12 after veneer 16 and layer 14 are bonded together where Tellman indicates layer 12, layer 14, and veneer 16 are all bonded together and does not indicate any restrictions on the particular order of bonding.

With respect to the new limitation of "wherein said pierced slots do not cause appreciable expansion of the resulting wood board", this is new matter. In any event, the expansion caused by Tellman's process is considered included in the bounds of appreciable expansion in that the veneers of Tellman do expand yet the degree of expansion incorporated by appreciable expansion does not have defined limits in the pending application.

Claims 10-11, 20, and 24, as discussed above, layer 12, layer 14, and veneer 16 are all longitudinally sliced wood veneer sheets. **Claims 11, 20, and 24**, layer 14 and veneer 16 are successively oriented during bonding.

Claims 11, 20, and 24, Tellman does not teach making layer 12, layer 14 and veneer 16 by rotary cutting.

However, layer 14 and veneer 16 are cut from species which is longitudinally cut depending upon the frame of reference, and rotary cutting of veneer layers from species (i.e., tree logs) is conventional because such allows one use of almost the entire log, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Tellman rotary cutting to obtain layer 12, layer 14, and veneer 16.

Claim 12, layer 12, layer 14, and veneer 16 are longitudinally cut and rotary cut; thus, the type of cut is alternating in each respective layer. **Claim 13**, veneer 16 with layer 14 have tight sides facing in opposite direction should the tight side of layer 14 up in Figure 1. **Claim 17**, in Tellman the core includes layers 14 and 16, an even number.

Claims 18-19 and 23, Tellman does not teach making the board of the claimed thickness with layers of the claimed thickness.

However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955).

Claims 21-22 refer to and intended use of the claimed board made by the elected process claim. Such does not further limit the method of making the wood boards.

Allowable Subject Matter

11. Claims 14-15 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Note also the objection to claims 14-15.

12. The following is a statement of reasons for the indication of allowable subject matter:

claim 14: Tellman does not teach that the veneer sheets of the core, layers 14 and 16, are oriented such that the tight sides of each successive pair of veneer sheets face each other;

claim 15: Tellman does not teach that the veneer sheets of the core, layers 14 and 16, are oriented such that the tight sides of each successive pairs of veneer sheets face away from each other; and

13. As allowable subject matter has been indicated, Applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Comments

14. Applicant's comments filed 1-9-04 have been fully considered. The comment with respect to the size of the slots and the spacing therebetween (page 10 of response, lines 3-18) is noted; however, these values (0.375 by 0.75 inches; 0.375 axial space; 0.75 transverse space) which Applicant indicates a providing unexpected results

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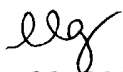
are not in the pending claims. And, the new limitation added to claim 9 is new matter. The referenced Declaration has not been filed in the pending application.


Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg 
June 28, 2004


LINDA GRAY
PRIMARY EXAMINER